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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,780	07/27/2001	Yi Li	883933.0066	9604

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EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,780

Applicant(s)

LI ET AL.

Examiner

Georgia L. Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 38-62 is/are pending in the application.
- 4a) Of the above claim(s) 38-49 and 52-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of the Claims***

1. The Office acknowledges receipt of Applicants Response; dated 4 October 2004.
2. Applicant has cancelled claims 1-37, and added new claims 49-62. Claims 38-62 are pending. Claims 49-62 are examined in the instant action. Claims 38-48 are withdrawn as being drawn to a non-elected invention.
3. This action is made FINAL necessitated by Applicant's amendment.
4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Restriction/Election***

6. Newly submitted claims 49-62 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly added claims are directed to the following distinct inventions:

- VII. Claims 49 and 51-62, drawn to a method for transient conveyance of a trait to a plant, comprising a cassette comprising a FRT/loxP site, a FLP/Cre coding sequence and a LoxP or FRT excision site, classified in class 800, subclass 278, for example.
- VIII. Claims 50-62, drawn to a method for transient conveyance of a trait to a plant, comprising a cassette comprising a FRT site, a loxP site, a FLP coding sequence, and a Cre coding sequence, classified in class 800, subclass 278, for example.

Art Unit: 1638

7. Inventions VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions they have different modes of operation, different functions, or different effects. The group V products have different starting materials and different steps than the group VI products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 49 and 51-62 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 50-62, drawn to a method comprising a cassette comprising FRT site, a loxP site, a FLP coding sequence, and a Cre coding sequence, are examined in this action.

### ***Objection***

8. Claims 49 and all claims dependent thereon are objected to as reciting nonelected inventions

### ***Sequence Listing***

Art Unit: 1638

9. Applicant remains not in compliance with the sequence requirements as set forth in 37 CFR 1.82-1.85 (see claim 48, for example). Attached are documenting papers setting forth the required response.

***Claim Rejections - 35 USC § 112, second paragraph***

10. Claims 50-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All dependent claims are also rejected.

In Claim 50,

- In step (a), "comprising 5' -3' " is confusing. Suggested language is "comprising in the 5' to 3' direction".
- what is an "excision site"?
- In line 4, it is suggested that Applicant clarify that the promoter is an inducible promoter, as step (c) requires activating the promoter.
- In step c, "activating the promoter to induce expression of FLP and Cre" will only function when the two coding sequences have appropriate nexus with the promoter. This relationship needs to be clarified.

In claim 51, "gene" is unclear because a "gene" implies a DNA sequence that exists in nature and includes coding and noncoding regions, as well as all regulatory sequences associated with expression. Since this does not appear to be Applicant's intention, the language "a DNA of interest" is suggested. Or

Art Unit: 1638

Applicant may recite the various components of the "gene" desired. All subsequent recitations of this language are also rejected.

- As there multiple excision sites, it is unclear which excision sites are being referenced in claim 51.

In claims 53-55, only disease resistance and sterility are traits. The other items listed are not traits as they are not distinguishing characteristics. For example, while "compact appearance" may be a trait, "appearance" in general is not a trait. In claim 55, what is the plant phenotype trait of "appearance"?

In claims 57-59, what is the relationship of "the transcription factor specific" to the externally activated promoter? Is this a functional relationship?

Clarification and/or correction are required.

***Claim Rejections - 35 USC § 112, first paragraph***

11. Claims 50-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, for reasons of record as set forth in the Office Action of 1 Jun 2004.

***Remarks***

12. No claim is allowed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1638

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on 8:30 - 5:00.

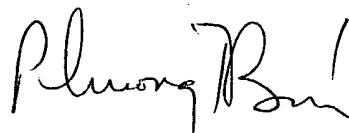
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia L. Helmer  
Patent Examiner  
Art Unit 1638  
December 27, 2004



PHUONG T. BUI  
PRIMARY EXAMINER



12/27/04